

**REMARKS**

As a preliminary matter, it is respectfully submitted that the enclosed amendment simply reduces issues and does not raise any issues that would require further consideration and/or search, so that entry is respectfully requested to place the application in immediate condition for allowance or in better form for appeal.

Claims 5-6 stand rejected under 35 U.S.C. § 112, first paragraph. Although traversed, this rejection has been rendered moot in view of the cancellation of claim 5 and amendment to claim 6, which amendments were made without prejudice/disclaimer. Accordingly, it is respectfully requested that the rejection be withdrawn.

Claims 2 and 8 are independent and stand rejected under 35 U.S.C. § 102 as being anticipated by Kuchta et al. '831 ("Kuchta"). This rejection is respectfully traversed for the following reasons.

The Examiner has maintained the pending rejection based on his interpretation that the image buffer 18 of Kuchta corresponds to the claimed "storage medium" and that the memory card 24 of Kuchta corresponds to the claimed "image memory" (see page 6, lines 11 and 21 of the outstanding Office Action). The Examiner then concludes that Kuchta discloses the image data is transferred from the alleged image memory 24 to the alleged storage medium 18 (see page 2, last four lines – page 3, line 17 of the outstanding Office Action).

However, the referenced portions of Kuchta, contrary to the Examiner's allegations, do not disclose or suggest **compressed** data ever being stored in the alleged storage medium 18, much less that the "image data ... is transferred from the [alleged] image memory [24] to the

[alleged] storage medium [18] ... ” as recited in claim 2. It should be noted that claim 2 recites in pertinent part, “an interface for recording the *compressed* image data, which has been once stored on the image memory, on a storage medium” (emphasis added).

In contrast, the alleged storage medium 18 of Kuchta merely receives the initial *uncompressed* image signal, which is then outputted from the alleged storage medium 18 to subsequently be compressed by the compressor 22 (*see* col. 4, lines 1-8). Accordingly, the alleged storage medium 18 does not store *compressed* image data. It follows that the alleged image memory 24 does not transfer the compressed “image data ... to the [alleged] storage medium [18].” Rather, the alleged image memory 24 outputs the image data *for display* as clearly shown in Figure 1A (*see also* col. 4, lines 53-68). Indeed, the alleged storage medium 18 forms part of the initial input section 2 and is outside of the compression/recording section 4 of the Kuchta device (*see* Figure 1A). In such a configuration, as shown in Figure 1A, the alleged storage medium 18 merely serves as an input buffer and does not receive image data, much less *compressed* image data, from any source other than from the exposure section 10/converter 16 which output the *uncompressed* signal to the buffer 18.

Accordingly, it is respectfully submitted that Kuchta does not disclose or suggest, *inter alia*, “an interface for recording the *compressed* image data, which has been once stored on the image memory, on a storage medium” for the reasons discussed above, let alone suggest transferring compressed “image data ... from the image memory to the storage medium while the series of images is presented by the display.”

As anticipation under 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that “inherency may not be established by probabilities or possibilities”, *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)), in a

single prior art reference, *Akzo N.V. v. U.S. Int'l Trade Commission*, 808 F.2d 1471 (Fed. Cir. 1986), based on the forgoing, it is submitted that Kuchta does not anticipate claims 2 and 8, nor any claim dependent thereon.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claims 2 and 8 are patentable for the reasons set forth above, it is respectfully submitted that all claims dependent thereon are also patentable. In addition, it is respectfully submitted that the dependent claims are patentable based on their own merits by adding novel and non-obvious features to the combination.

Based on the foregoing, it is respectfully submitted that all pending claims are patentable over the cited prior art. Accordingly, it is respectfully requested that the rejections under 35 U.S.C. § 102/103 be withdrawn.

### **CONCLUSION**

Having fully responded to all matters raised in the Office Action, Applicants submit that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper,

**Application No.: 09/963,551**

including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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